

II. RESTRICTION TO GROUPS I-V FAILS TO ESTABLISH A PRIMA FACIE CASE.

Restriction to Group I is respectfully traversed. In order to establish a *prima facie* case for restriction, related inventions require a showing of distinctiveness *and* reasons for restriction. MPEP § 805.05(c). Inventions are referred as “distinct” if two or more subjects are disclosed are (1) capable of separate manufacture, use or sale as claimed, and (2) are patentable (novel and unobvious) over each other. MPEP § 802.01. Further, an explanation for the restriction must be given demonstrating one of the following: separate classification, separate status in the art when classified together or a different field of search. MPEP § 808.02.

Groups I-V are classified by the Examiner in the same class and subclass, class 536, subclass 23.1. This identical classification fails to provide that each Group has attained recognition in the art as a separate subject for inventive effort and also a separate field of search. MPEP § 808.02.

The Examiner contends that “each method differs in method steps, modes of operation, reagents needed and serve different endpoints and effects.” However, this explanation neglects to show how each Group, even classified together, has a separate status in the art. MPEP § 808.02.

Further, there is no indication (evidence) that it is necessary to search for one of the Groups in places where no pertinent art to the other Groups exists. There is also no clear indication of separate future classification and field of search of the Groups I-V. MPEP § 808.02.

Additionally, as indicated in MPEP § 803, if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinctive inventions. In the present case, the claims represented in Groups I-V are all directed to methods specifically adapted for modifying the activity of a nucleotide binding protein. Applicant respectfully submits that a search directed to these claims could be made without serious burden.

III. CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests that the Examiner consolidate Groups II-V into Group I and limit the restriction to Groups I-V (method) and Group VI (composition). Should the Examiner believe anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment to deposit account number 03-2469. Moreover, if the deposit account contains insufficient funds, the Commissioner is hereby invited to contact Applicant's undersigned representative to arrange payment.

Respectfully submitted,



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